

REMARKS

Receipt of the Office action of December 20, 2005 is hereby acknowledged. In that action the Examiner: 1) required affirmation of an election made by telephone on December 6, 2005; 2) rejected claims 12, 16, 22, and 26 as allegedly anticipated by Horton (U.S. Pat. No. 5,969,770); 3) rejected claims 17 and 27 as allegedly unpatentable over Horton; 4) rejected claim 13 as allegedly unpatentable over Horton in view of Yahav et al. (U.S. Pat. No. 6,057,909); 5) rejected claims 14 and 15 as allegedly unpatentable over Horton in view of Callway et al. (Pub. No. 2003/0027517); 6) rejected claims 23-25 as allegedly unpatentable over Horton in view of MacInnis et al. (U.S. Pat. No. 6,853,385); and 7) objected to the specification. Based on an election made by telephone, herein affirmed, consideration of claims 1-11, 18-21, and 28-30 has been withdrawn.

With this Response, Applicants amend claims 12, 22 and 23 and cancel claims 18-21 and 28-30. Applicants believe the pending claims are allowable over the art of record and respectfully request reconsideration.

I. RESTRICTION REQUIREMENT

Applicant hereby affirms the election to prosecute the claims of Group II (claims 12-17 and 22-27) made by telephone on December 6, 2005. Applicants also respectfully traverse the required restriction between claims in Group I (claims 1-11) and Group II.

The Manual of Patent Examining Procedures (MPEP) states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

MPEP, Section 803. Applicants respectfully submit that there will be no serious additional burden on the Examiner to examine the claims of both Group I and Group II. For example, claim 1 (in Group I) requires:

combining a digital graphics object and a digital picture while both the digital graphics object and the digital picture are in a compressed format.

(Claim 1). Also, claim 22 (in elected Group II), specifically requires:

overlays a graphics object onto a picture while both the graphics object and the picture are in a compressed format.

(Claim 22). Thus, the Examiner, in examining the Group II claims will need to search this and other aspects of the claimed invention of Group II. The search, by its very nature, overlaps with the search that may be required with respect to Group I.

Based on the foregoing, Applicants respectfully submit that while there may be separate inventions, there will be no serious additional burden on the Examiner to examine the claims of both Group I and Group II.

II. AMENDMENTS TO THE SPECIFICATION

With respect to paragraph [0035], [0042], and [0043], Applicants present a plurality of amendments to correct grammatical shortcomings. No new matter is added.

III. ART-BASED REJECTIONS

A. Claim 12

Claim 12 stands rejected as allegedly anticipated by Horton. Applicants amend claim 12 to more clearly define over Horton's overlay scheme. The amendment finds support in the original specification at Paragraphs [0034]-[0036], [0038], and [0040]-[0041].

Horton is directed to animated "on-screen" display provisions for an MPEG video signal processing system. (Horton Title). In particular, Horton appears to disclose an apparatus for providing OSD graphics (Horton Col. 2, lines 36-37). Horton teaches that prior to overlaying a graphics image with a video image, the graphics image is compressed (Horton Col. 8, lines 4-8). In particular, the graphics image is compressed by selectively including or excluding color difference components (i.e., chrominance value) for successive pixels, without allowing for the possibility of retaining partial values for each pixel. Specifically, for every two graphics pixels, the graphics image data converter selects the pair of color difference components for the first pixel and deletes the pair for the second pixel (Horton Col. 8, lines 8-11). Thus, Horton's overlay scheme is an

unweighted overlay scheme wherein each pixel's chrominance value is either fully included or fully excluded.

Claim 12, by contrast, specifically recites, "wherein the processor, executing a program, overlays a digital graphics object and a digital picture **based on a weight factor**". Applicants respectfully submit that Horton does not expressly or inherently teach such a system. Horton teaches an overlay scheme that fully includes or fully excludes each pixel's chrominance value. Horton is silent as to assigning weighted values to each pixel's chrominance value as part of the overlay process. Instead, Horton teaches indiscriminate inclusion and exclusion of the chrominance values of succeeding pixels. Thus, Horton fails to expressly or inherently teach a system "wherein the processor, executing a program, overlays a digital graphics object and a digital picture **based on a weight factor**".

Based on the foregoing, Applicants respectfully submit that claim 12, and all claims which depend from claim 12 (claims 13-17), should be allowed.

B. Claim 22

Claim 22 stands rejected as allegedly anticipated by Horton. Applicants amend claim 22 to more clearly define over Horton's image compression scheme. The amendment finds support in the original specification at Paragraphs [0034]-[0036], [0038], and [0040]-[0041].

Horton teaches an unweighted overlay scheme wherein each pixel's chrominance value is either fully included or fully excluded. Claim 22, by contrast, specifically recites, "A computer readable media storing a program that, when executed by a processor, performs a method comprising overlaying a graphics object onto a picture **based on a weight factor**." Applicants respectfully submit that Horton does not expressly or inherently teach such a computer readable media. Horton teaches an overlay scheme that fully includes or fully excludes each pixel's chrominance value. Horton is silent as to assigning weighted values to each pixel's chrominance value as part of the overlay process. Instead, Horton teaches indiscriminate inclusion and exclusion of the chrominance values of succeeding pixels. Thus, Horton fails to expressly or inherently teach "A computer readable media storing a program that, when executed by a

processor, performs a method comprising overlaying a graphics object onto a picture based on a weight factor."

Based on the foregoing, Applicants respectfully submit that claim 22, and all claims which depend from claim 22 (claims 23-27), should be allowed. Applicants amend claim 23 to correct grammatical deficiencies. No new matter is added.

IV. CLAIM CANCELLATIONS

With this Response, Applicants cancel claims 18-21 and 28-30 without prejudice to later asserting the claim, such as in a divisional application.

V. CONCLUSION

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

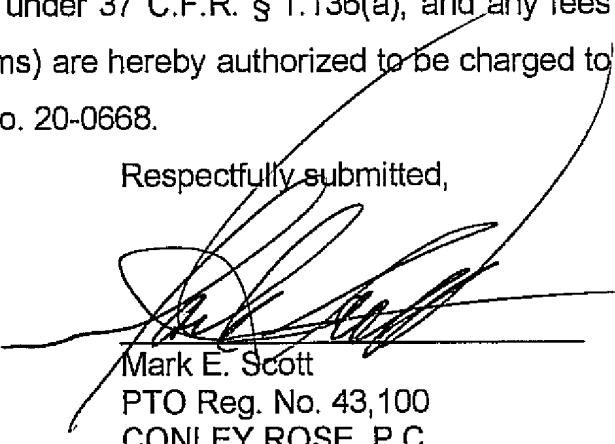
Serial No.: 10/823,183

Response to Office Action Dated December 20, 2005

Amendment Dated August 4, 2006

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. If the Examiner feels that a telephone conference would expedite the resolution of this case, he is respectfully requested to contact the undersigned. It is believed that no extensions of time or fees are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to the Texas Instruments, Inc. Deposit Account No. 20-0668.

Respectfully submitted,



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